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TO	Examiner D. Hamlin	FROM	John E. McGarry
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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Eric J. Hansen and Jesse J. Williams
For: EXTRACTION CLEANING WITH OXIDIZING AGENT
Serial No.: 09/589,973 Examiner: Derrick G. Hamlin
Filed: 06/08/2000 Group Art Unit: 1751
Atty. Docket: 71189-1300 Confirmation No.: 9893

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AMENDMENT AND RESPONSE TO OFFICE ACTION

This paper is in response to the Office Action mailed February 27, 2002.

In the Office Action, claims 1-28, all of the claims in this application, have been rejected under 35 U.S.C. § 103(a) as being unpatentable over the Shindo et al. U.S. Patent No. 5,853,430 and further in view of Ligman U.S. Patent No. 5,555,595 or Sham U.S. Patent No. 5,386,612. This rejection is respectfully traversed.

The Shindo et al. '430 patent discloses a method for predissolving detergent compositions in which a detergent composition and a solvent are combined in a hand held container to form a concentrated detergent solution. The solution is said to be suitable for pretreating garments to remove tough soils and stains. The detergent composition includes a bleach and/or a bleach activator. The bleach is preferably peracid bleach and/or a peroxygen bleach. The detergent composition preferably also includes a surfactant. The peroxygen bleaches can include hydrogen

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peroxide, inorganic peroxohydrates, organic peroxohydrates and organic peroxyacids including peroxycarboxylic acids. Peroxyhydrates include perborates, percarbonates, perphosphates, and persilicates. Bleach activators such as TAED can also be used in the composition. Although hard surface cleaning is disclosed in the Shindo et al. '430 patent, all of the examples of use relate to pretreating a fabric for the use of the composition of the invention in a washing machine.

The Ligman '595 patent discloses a carpet cleaner which includes a heater for heating a cleaning solution that is sprayed onto a floor. The carpet cleaner operates in a manner of a conventional extraction carpet cleaner well known in the carpet cleaning art.

The Sham '612 patent discloses a portable steam vacuum cleaner wherein water is heated to produce steam. An extraction system removes soiled water from a surface to be cleaned. The Sham device is preferably used for generating steam for delivery to a flat surface, such as a window, floor or table to be cleaned. Water or a cleaning solution such as, for example, soapy water can be used in the reservoir of the Sham cleaner.

The rejection appears to hold that the claims are unpatentable over Shindo et al. '430, alone, and further in view of either Ligman '595 or Sham '612. The Examiner acknowledges that the Shindo '430 patent does not disclose the concept of Applicants' invention as defined in claim 1:

The primary reference is deficient, as it fails to teach a carpet cleaning machine employing the cleaning solution disclosed. The primary reference does indicate that the composition is applicable to many types of cleaning operations for surfaces and that machines may be employed. Therefore, one would be motivated to employ one of the following carpet cleaning machines to clean the carpet with the carpet cleaning solution of the reference. (Office Action, p. 3-4)

It is quite clear that the Shindo et al. '430 patent does not disclose a method for cleaning an upholstery or carpet surface in which a fluid carpet or upholstery cleaning solution is dispensed onto the upholstery or carpet surface to be cleaned and the cleaning solution is recovered from the surface with suction. For this reason, claim 1 and dependent claims 2-28, patentably define over the Shindo et al. '430 patent.

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Contrary to the Examiner's representation, there is no hint or suggestion in Shindo of a carpet or upholstery cleaning solution. The Shindo et al. '430 patent is principally related to laundry detergents. Whereas the Shindo et al. '430 patent discloses a washing machine for use of the Shindo et al. '430 cleaning compositions, a washing machine is not a carpet or upholstery cleaner as the Examiner has well recognized.

The alleged combination of Shindo et al. '430 with either Ligman '595 or Sham '612 is traversed. There is no basis for making the alleged combination. There is not even a hint of suggestion of the combination and the Examiner has given none. The Examiner has merely alleged obviousness of the combination without any basis in any of the references to suggest the combination.

The Examiner's attempt to find a basis for the alleged combination of references finds no support in any of the references. The Examiner is respectfully requested to consider the recent decisions of the United States Court of Appeals for the Federal Circuit with respect to the issue of obviousness. In particular, the Examiner's attention is directed to Ecolchem, Inc. v. Southern California Edison Co., Case 99-1043 decided September 7, 2000, 227 F.3d 1361; 56 USPQ2d 1065, (<http://www.ll.georgetown.edu/Fed-Ct/Circuit/fed/opinions/99-1043.html>) at 1371-1372 in which the Court stated:

Our case law makes clear that the best defenses against hindsight-based obviousness analysis is *the rigorous application of the requirement for a showing of a teaching or motivation to combine the prior art references*. See Demibiczak, 174 F.3d at 999, 50 USPQ2d at 1617. "*Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability--the essences of hindsight.*" Id.

"When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references." In re Roufet, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998) (citing In re Geiger, 815 F.2d 686, 688 2 USPQ2d 1276, 1278 (Fed. Cir. 1987)). The

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same principle applies to invalidation. "Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). Although the suggestion to combine references may flow from the nature of the problem, see Pro-Mold & Tool Co. v. Great lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996), "[d]efining the problem in terms of its solution reveals improper hindsight in the selection of the prior art relevant to obviousness," Monarch Kitting Mach. Corp. v. Sulzer Morat GmbH, 139 F.3d 877, 880, 45 USPQ2d 1977, 1981 (Fed. Cir. 1998). Therefore, "[w]hen determining the patentability of a claimed invention which combines two known elements, 'the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination.'" In re Beattie, 974 F.2d 1309, 1311-12, 24 USPQ2d 1040 1042 (Fed. Cir. 1992) (quoting Lindemann, 730 F.2d at 1462, 221 USPQ at 488). (Emphasis added.)

The Examiner has erred in attempting to use the Applicants' disclosure as a blueprint for hindsight-based arguments and has not comported with the standards of the United States Court of Appeals for the Federal Circuit.

The Examiner's attention is also directed to In re Sang-Su Lee, 00-1158, decided January 18, 2002, 277 F.3d 1338; 61 USPQ2d (BNA) 1430 (<http://www.ll.georgetown.edu/Fed-Ct/Circuit/fed/opinions/00-1158.html>) at pages 1342-1344 which holds as follows:

As applied to the determination of patentability *vel non* when the issue is obviousness, "it is fundamental that rejections under 35 U.S.C. § 103 must be based on evidence comprehended by the language of that section." In re Graselli, 713 F.2d 731, 739, 218 USPQ 769, 775 (Fed. Cir. 1983). The essential factual evidence on the issue of obviousness is set forth in Graham v. John Deer Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966) and extensive ensuing precedent. The patent examination process centers on prior art and the analysis thereof. When

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patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness. See, e.g., McGinley v. Franklin Sports, Inc., 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001) ("the central question is whether there is reason to combine [the] references," a question of fact drawing on the Graham factors).

"The factual inquiry whether to combine references must be thorough and searching." Id. It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with. See, e.g., Brown & Williamson Tobacco Corp. v. Philip Morris Inc., 229 F.3d 1120, 1124-25, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000) ("a showing of a suggestion, teaching, or motivation to combine the prior art references is an 'essential component of an obviousness holding'" (quoting C.R. Bard, Inc. v. M3 Systems, Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998)); In re Dembiczak, 175 F.3d 994, 999 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references."); In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998) (there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant); In re Fine, 837 F.2d 1071, 1075 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) ("teachings of references can be combined only if there is some suggestion or incentive to do so.") (emphasis in original) (quoting ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)).

The need for specificity pervades this authority. See, e.g., In re Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("particular

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findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed"); In re Rouffet, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) ("even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of the ordinary skill, that suggests the claimed combination. In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious."); In re Fritch, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (the examiner can satisfy the burden of showing obviousness of the combination "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references").

With respect to Lee's application, neither the examiner nor the Board adequately supported the selection and combination of the Nortrup and Thunderchopper references to render obvious that which Lee described. The examiner's conclusory statements that "the demonstration mode is just a programmable feature which can be used in many different device[s] for providing automatic introduction by adding the proper programming software" and that "another motivation would be that the automatic demonstration mode is user friendly and it functions as a tutorial" do not adequately address the issue of motivation to combine. This factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." W.L. Gore v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983). Thus the Board must not only assure that the requisite findings are made, based on evidence of record, but must

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also explain the reasoning by which the findings are deemed to support the agency's conclusion.

Like the Examiner in In re Sang-Su Lee, the Examiner in this application has not adequately addressed the issue of motivation to combine the references. Simply pointing out Applicants' disclosed solution to a problem or some speculative beneficial result of the combination does not meet the requirement of motivation to combine the references.

The Examiner's conclusory statement of obviousness with the expected results does not satisfy the standard of 35 U.S.C. § 103(a) as articulated by the United States Board of Appeals for the Federal Circuit in the *Ecolochem* and the *Sang-Su Lee* cases cited above. Thus, the Examiner's alleged combination of either Ligman '595 or Sham '612 with Shindo '430 is inappropriate.

In view of the foregoing, it is apparent that claims 1-28 are patentable over the alleged combination of Shindo et al. '430, either alone or in combination with Sham '612 or Ligman '595. Withdrawal of the rejection of claims 1-28 is requested.

Submitted herewith is a Declaration of Jesse J. Williams under 37 C.F.R. § 1.132. The Williams Declaration avers a completion of the invention of at least claim 1 before September 3, 1997, the filing date of the Shindo et al. '430 patent. Thus, the Shindo et al. '430 patent is not an appropriate reference against the claims in this application.

In view of the foregoing remarks and amendments it is submitted that all of the claims in the application are allowable. Early notification of allowability is respectfully requested.

Respectfully submitted,

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Dated: 5-04-02

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